Office Supreme Court, U.S.
FILED
APR 24 1964
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1963.

No. 1034

AXEL HARALD HOLSTENSSON AND GLENVILLE INDUSTRIES, INC.,

Petitioners,

vs.

V-M CORPORATION,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

DONALD J. SIMPSON,
LEWIS T. STEADMAN,
53 W. Jackson Blvd.,
Chicago 4, Illinois,

ROBERT G. HOWLETT,
Michigan Trust Bldg.,
Grand Rapids 2, Michigan,
Attorneys for Petitioners.

THE GUNTHORP-WARREN PRINTING COMPANY, CHICAGO

INDEX

	PAGE
Citations to Opinions Below	1
Statutes and Treaty Involved	2
Jurisdiction	2
Conflicting Decisions	2
Conflict With a Treaty Between Sweden and the United States	3
Conflict With Requirement by United States Patent Office Which Patentees Were Forced to Accept	4
Questions Presented	4
Statement	5
Reasons for Granting the Writ	8
Conclusion	20
Appendix to Petition	21
Opinion Below	21
Judgment Below	53
Order Denying Petition for Rehearing Below	54
Statutes 35 U. S. C. 102	55
Statutes 35 U. S. C. 103	56
Statutes R. S. 4887	56

Table of Authorities.

Cases.

Aluminum Company of America v. Sperry Products, Inc. (1960), 285 F. (2d) 911, 917, Certiorari Denied, 368 U. S. 890 13

Cold Metal Process Co. v. Republic Steel Corp. (1956), 233 F. (2d) 828, 838, Certiorari Denied, 352 U. S. 891 13

Gibson-Stewart Company, Inc. v. Wm. Bros. Boiler and Manufacturing Co. (1959), 264 F. (2d) 776, Certiorari Denied, 360 U. S. 929 13

Goodyear Tire and Rubber Company, Inc. et al. v. Ray-O-Vac Company, 321 U. S. 275 ..... 15, 16

Holstensson v. Webcor, Inc., 150 F. Supp. 441 ..... 2, 10

Williams Manufacturing Co. v. United Shoe Machinery Corporation, 316 U. S. 364 ..... 14, 15, 16

Karl Zysset et al. v. Popeil Brothers, Inc., 276 F. (2d) 354, 357, Certiorari Denied, 364 U. S. 826 ..... 3, 9

Karl Zysset et al. v. Popeil Brothers, Inc., 318 F. (2d) 704, Certiorari Denied, 84 Sup. Ct. 658, Rehearing Denied March 23, 1964 ..... 3, 9

Statutes.

35 U. S. C. Sections 102 and 103 ..... 2, 8

R. S. 4887-49 Stat. 1529 (Now 35 U. S. C. 119) 2, 17, 18

53 Stat. 1768, 1774 ..... 2, 17

IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No.

AXEL HARALD HOLSTENSSON AND GLENVILLE INDUSTRIES, INC.,

Petitioners,

vs.

V-M CORPORATION,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

Petitioners pray that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Sixth Circuit entered in the above-entitled cause on November 21, 1963.

CITATIONS TO OPINIONS BELOW.

The opinion of the United States District Court for the Western District of Michigan, Southern Division, holding the claim 1 of the patent in suit valid and infringed is reported in 198 F. Supp. 779, and is reproduced at page 151a et seq. of the Record, nine copies of which are filed herewith pursuant to rule 21(4).

The opinion of the Court of Appeals for the Sixth Cir-

cuit reversing the judgment of the District Court is reported in 325 F. 2d 234, and is reproduced at page 21 of the Appendix hereto.

STATUTES AND TREATY INVOLVED

The statutory provisions involved are: Sections 102 and 103 of U. S. C. Title 35; R. S. 4887 (R. S. 4887, 49 Stat. 1529—now 35 U. S. C. 119) reproduced at pages 55, 56 of the Appendix hereto; and the International Convention, 53 Stat. 1768, 1774 portions of which are quoted at page 17 of this petition.

JURISDICTION

The judgment of the Court of Appeals was entered on November 21, 1963. Rehearing was denied on January 27, 1964. Jurisdiction of this Court is invoked under 28 U. S. C., Sections 1254(1) and 2101(c).

CONFLICTING DECISIONS

The present judgment of the Court of Appeals of the Sixth Circuit is in direct conflict with a judgment of a Court from the Seventh Circuit, namely the United States District Court for the Northern District of Illinois, Eastern Division, 150 F. Supp. 441, from which no appeal was carried through by the defendant therein. In the Illinois case the same claim as here involved was held valid and infringed, and in so doing a contrary interpretation of the same point of law was rendered.

Additionally, there are now irreconcilable decisions of two different Courts of Appeal on a basic interpretation of Federal law which is certain to lead to confusion in the future. Specifically, the present decision by the *Sixth Circuit Court of Appeals* is in direct conflict with the recent decisions by the *Seventh Circuit Court of Appeals* in *Karl Zysset et al.* v. *Popeil Brothers, Inc.*, reported at 276

F. (2d) 354. Certiorari denied 364 U. S. 826, and confirmed in the accounting proceedings 318 F. (2d) 704. Petition for Certiorari in the latter *Popeil* case was denied 84 Sup. Ct. 658, and Petition for Reconsideration was denied on March 23, 1964.

The point of conflict is the test which the two Courts of Appeal have laid down to determine the patentability of a patent claim directed to a combination of mechanical elements. The Sixth Circuit for the first time in its present decision and contrary to its earlier rulings has, in effect, said that every element of a combination must be either new or perform a new function in order for the claim to be patentable. The Seventh Circuit has consistently said that the individual elements may be old in the art and still provide a patentable combination if there is some newness in the combination either because of the presence of some new elements or because the combination as a whole is new or improved.

CONFLICT WITH A TREATY BETWEEN SWEDEN AND THE UNITED STATES.

The present judgment of the Sixth Circuit Court of Appeals is also in conflict with certain treaty rights existing between the United States and Sweden. Under a long existing treaty between these two countries, patent rights in the United States cannot be affected by any interpretation under Swedish law of any corresponding Swedish patent nor by any acts occurring in the Swedish Patent Office after the filing of the Swedish application.

The Sixth Circuit Court of Appeals disregarded the treaty provisions and improperly predicated its decision, at least in part, on legal procedural steps occurring in the Swedish Patent Office after the filing of the original application and by interpreting the effect of those steps in Sweden under Swedish law.

This was done notwithstanding the fact that no evidence was ever offered as to what the Swedish law was, nor as to what the effect would be under Swedish law of the steps taken in the Swedish Patent Office.

CONFLICT WITH REQUIREMENT BY UNITED STATES PATENT OFFICE WHICH PATENTEES WERE FORCED TO ACCEPT.

The present judgment of the Sixth Circuit Court of Appeals has inequitably placed the patentees in the peculiar position of having their patent declared invalid because too many elements were included in the combination recited by the claim in suit, notwithstanding the fact that the United States Patent Office had required additional elements be added to be complete. This is clearly denying the patentees their justifiable rights on a legal technicality, notwithstanding the fact that they had admittedly made an important inventive contribution to the development of the art.

QUESTIONS PRESENTED.

1. Must every element of a combination be new or perform a new function for a combination claim to be patentable?

2. When the Constitutional and Statutory tests for invention have been met, as here found by the Sixth Circuit Court of Appeals as well as by two District Courts should claim 1 of the patent in suit be struck down for claiming a complete and working apparatus rather than only a portion thereof having no function whatever apart from such a complete apparatus?

3. May a United States Court disregard the provisions of a treaty which the United States has with Sweden, and, contrary to the treaty rights of the Swedish patentees, rely on interpretations of Swedish law and Swedish Pat-

ent Office practice as a basis for determining the legality of an American patent, and particularly where no evidence was introduced as to what the Swedish law is in this regard?

4. Was the Constitutional and Statutory standard for patentable invention as established by this Court met and satisfied by claim 1 of the patent in suit, the patent having already been recognized by the entire industry and by District Courts in two different Federal judicial circuits?

5. Should a Federal Court hold a combination claim invalid solely on the grounds that too many elements are included, after the United States Patent Office has required additional elements be added to make the claim complete?

STATEMENT.

Petitioners here, plaintiffs below, filed suit on November 4, 1954 in the United States District Court for the Western District of Michigan, Southern Division, alleging infringement of the Holstensson et al Patent 2,291,158. Jurisdiction was based upon the Patent Laws 35 U. S. C., and 28 U. S. C. 1400. The case was tried without a jury beginning on February 16, 1959 and finishing on February 20. A great deal of testimony was heard and on August 22, 1961, the District Court rendered a decision holding the claim in suit to be valid and infringed.

Defendant thereafter filed an appeal limited solely to the question of whether or not the claim in suit was invalid for reciting a novel element in combination with old parts that perform no new or improved function. At the oral argument before the Court of Appeals, Defendant admitted through its counsel that at least one element of the combination recited by the claim in suit was novel and invention, that it was using the combination including the novel element, and that the rest of the industry had recognized the patent and had paid royalties thereunder. Defendant went on, how-

ever, and argued that it was entitled to take advantage of the technical defense that the claim was invalid for having included too many elements as a part of the recited combination.

The claim in suit is directed to a combination of elements, some of which were new at the time of the invention and others of which were old as elements per se. The combination as a whole was new and an improvement, and the District Court so found this as a fact after listening to extensive testimony and examining many physical exhibits (Record pages 153a, 154a, 155a, 161a and 162a).

The subject matter of the patent in suit is an automatic phonograph record changer mechanism and specifically is that type of record changer which is almost universally used today to cause a plurality of disc records to be played in succession. This mechanism includes a record supporting turntable which is mounted for rotation about a vertical axis. A tone arm is mounted to one side of the turntable for angular movement in a horizontal plane and in a vertical plane. The fixed center post or spindle rises through the turntable at its center and is provided at its upper end with an offset portion. A plurality of records threaded from above onto the upper end of the spindle are supported by the shoulder formed by the offset portion. A lever is mounted for pivotal movement within the spindle and is rocked through the spindle from below. Shiftable steadying means is provided to engage selectively the upper surface of a stack of records which have been threaded from above onto the shoulder of the spindle to hold the records level and firmly thereon or to shift to an inoperative position at the side of the turntable for easy loading of records on the spindle, or unloading of the played records from the turntable. The machine includes regulating mechanism for raising the tone arm at the end of the playing of a record and for swinging it back to a point

where it is free of the path of a falling record and at this point, coact with the lower end of the lever to cause the lever to engage the center hole of the lowermost record and shift it laterally off of the spindle shoulder onto the turntable. The mechanism thereafter coacts to return the tone arm to a predetermined position where it is lowered onto the record which has just dropped onto the turntable.

When the inventors of the patent in suit made their invention incorporating a novel spindle, there was no existing structure in which, without change, the spindle could be put. There were cycling mechanisms of many sorts including the structure of an earlier patent to Arvidius, Reissue Patent Re. 20,819, but none could be used without modification. The spindle by itself had no useful function. It took the insight and acumen of Holstensson and Arvidius to conceive the novel spindle and a new arrangement of elements operating in conjunction therewith which in the end produced a combination so revolutionary that the great bulk of the industry turned to it and has used it ever since.

One element of the combination is a cycling mechanism and the Court of Appeals finds that this cycling mechanism was old as an element as shown in Reissue Patent Re. 20,819 and that when the new spindle was combined with it along with the new steadying means, no new combination resulted. The cycling mechanism of the reissue patent was of a type and character to drive side slicer blades from a position to one side of the records. This old cycling mechanism for side slicers could not be used with the new spindle without change. It was not simply a question of connecting an operating link of the slicer blades of the Arvidius cycling mechanism to the operating finger of the new center post spindle as suggested by the Court of Appeals. On the contrary, it was necessary to make a number of different changes. The turntable had to be

provided with, and mounted on, a rotatable hollow shaft to accommodate the active spindle mechanism shaft (a change made by Defendant-Appellant in DX 41). A movable steadying means had to be provided to engage the upper side of the stack of records which would permit simple record threading from above and then simple positive record support. The spindle operation had to be actuated from below in a manner regulated in timed relation to the tone arm to provide an operative record handling mechanism. The resulting record changing apparatus was the "subject matter as a whole," that is the combination, and was not "obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains" (the quoted portions being from Title 35, United States Code, Section 103). The function of the *overall* device was novel and vastly improved.

REASONS FOR GRANTING THE WRIT.

The Court of Appeals of the Sixth Circuit has promulgated a new standard and test for combination claims which is in direct conflict with controlling decisions of this Court, of the Court of Appeals of the Seventh Circuit and of the practice of the United States Patent Office. In particular, the Court has applied a new test which is to the effect that for a combination claim to be patentable, *every* element must be new or perform a new function. The Court of Appeals in effect is saying that if any element of a combination claim performs its old function, the combination claim is invalid. If this new test of invention is followed, it will eliminate substantially all combination claims. It is self-evident that some of the most significant advances in technology today have evolved from a rearrangement of known elements or from combining some old elements with one or more new elements. It was not because the old

elements were functioning per se in a different way, but rather that in their environment, created by the rearrangement, these elements have contributed to a *combination* which was different and which functioned in a new and improved way.

The Seventh Circuit Court of Appeals in *Karl Zysset et al.* v. *Popeil Brothers, Inc.*, 276 F. (2d) 354 and (318 F. (2d) 704), *supra*, rejected the test later followed by the Sixth Circuit and held that only a portion of the combination need be new. More specifically, in *Popeil* the Seventh Circuit held valid a combination patent claim over prior art because a novel idea was incorporated even though such novelty affected but part of the claimed combination—namely, the sinuous cutter blade and correspondingly slotted wiper cup of a vegetable chopper. In the present case, the Sixth Circuit Court of Appeals held invalid a combination patent claim that admittedly had novelty in a part of the claimed combination—namely, the spindle-type record-dropper portion of a complex automatic record changer.

Referring more particularly to the specific language of these two conflicting decisions, it will be noted in the *Popeil* decision that the Court found that "the sinuous blade constituted invention although found in a combination of other elements which were old in the art" (276 F. (2d) 354, 357). But note how differently the Sixth Circuit treats the same problem. In referring to the combination, the Court states "In the case at bar, one of the elements, the spindle type record changer was new and constituted invention. This *invention* was combined with another element, the cycling mechanism, which was old and disclosed in the Arvidius patent. * * * We therefore deal with a combination which brings together the new and the old" (325 F. (2d) 109, 120, Appendix 40, 41).

The Court of Appeals of the Sixth Circuit recognized that in using this different test for determining the patentability of a combination claim it was visiting *total forfeiture upon a patent which "contains patentable invention"*, merely because the patent included as a part of the combination claim an element which was old (325 F. 2d 109, 123, Appendix 44; 45).

Attention is also invited to the fact that the Sixth Circuit Court of Appeals decision is in direct conflict with a decision from the Seventh Circuit rendered by a United States District Court for the Northern District of Illinois, Eastern Division (*Holstensson v. Webcor, Inc.*, 150 F. Supp. 441) on exactly the same claim of the same patent. In the Illinois decision this claim was held valid and infringed after a full trial. An appeal was taken by the Defendant, Webcor, Inc., but was later dismissed. The Illinois Court found that:

> "Claim 1 of Patent No. 2,291,158 clearly and definitely recited a true combination of elements cooperating together in a new *modus operandi* to provide a novel and greatly improved apparatus for changing a plurality of records which may be of a predetermined single size. The claimed combination [ ] amounts to invention".
>
> Claim 1 in suit is directed to and defines a patentable combination of elements", (page 445.)

The District Court in the present suit reached the same conclusion as the Illinois Court following a second full trial (198 F. Supp. 779, Record 151a).

In addition to the views of the two District Courts, those who have viewed the present invention at the market place reached the same conclusion. As conceded by the Sixth Circuit Court of Appeals:

> "At the time of the trial in 1959, defendant V-M Cor-

poration was the only American manufacturer using the accused type of spindle without license from Holstensson or Glenville Industries" (325 F. 2d 109, 119, Appendix 38).

The Court of Appeals felt that the Illinois Court had not considered the legal questions hereinbefore referred to, and particularly did not consider the Arvidius Reissue Patent and did not discuss overclaiming. This conclusion is not substantiated by fact. The Arvidius Reissue Patent was in evidence (Record page 15b) along with several other cycling mechanisms such as the British patent to Collaro No. 460,501 and the British patent to Compare No. 454,106 (finding of fact No. 10).

The Illinois Court found that "Claim 1 of United States Patent No. 2,291,158 is good and valid in law" and that "claims are not invalid for *aggregation* where elements coact to produce a new result exceeding the sum of the functions of the elements alone, no matter whether the elements act simultaneously or successively" (excerpt from Conclusions of Law 6 and 14). Since the problem of "aggregation" is a problem of "overclaiming", it seems clear that the Illinois Court did deal with this question.

The Illinois Court also refused to give any weight to the activities in Sweden. Specifically, it found that the Swedish patents resulting from the original Swedish disclosure did not in any way negative the validity or scope of claim 1 here in suit, nor did either constitute a dedication to the public of the invention defined by this claim (Conclusion of Law 26).

The District Court in the present case fully recognized the six steps required for an automatic record changer which were:

"1. Set record onto turntable;
2. Swing pickup arm inwardly to playing position;
3. Lower pickup arm onto record;

4. Play record;
5. Raise pickup arm from record;
6. Swing pickup arm outwardly beyond edge of record." (Record 154a.)

and that

"Various and sundry means had been developed for the performance of all or part of these essential functions in the several patents cited by the defendant in opposition to the patent in suit." (Record 154a.)

The District Court found:

"There is no question but that the patent in suit shows in combination *a number of known elements* and describes a number of known elements. However it includes with the known elements a device which in Claim 1 is described—

"* * * a rotatable hollow shaft * * * a post extending through the shaft and having an upper extension which is offset with respect to the post for forming thereon a shoulder for supporting a stack of records threaded upon said extension * * * a lever pivotally mounted in said supporting post and having one end adapted to engage the edge of the central aperture of the lowermost record in said stack and to laterally displace said record to disengage it from said shoulder * * * said means (mechanically operating from below the turntable) also locking said lever into position disengaging said lowermost record whereby the latter drops on to said turntable * * *" (Record 153a.)

but concluded:

"Thus we are satisfied that the device originated by Arvidius and Holstensson was original in conception and unless it is barred for some other reason it was and is the subject of a valid patent. To hold that that patent and the Swedish application upon which it was based was anticipated by overhead bridge and slicing devices would be to ignore the realities of the situation as demonstrated by the units manufactured according to the teaching of the several patents and demonstrated to the trial judge in the open courtroom.

There is to the uninformed layman a vast difference not only in appearance but in function between the several devices." (Record 155e.)

The District Court relied on *prior decisions* of the Sixth Circuit certiorari for which had been denied by this Court. Specifically, the District Court relied on:

1. *Cold Metal Process Co.* v. *Republic Steel Corp.*, (1956) 233 F (2d) 828, 838, Certiorari Denied, 352 U. S. 891;
2. *Gibson Stewart Company, Inc* v. *Wm. Bros. Boiler and Manufacturing Co.*, (1959) 264 F (2d) 776, Certiorari Denied 360 U. S. 929;
3. *Aluminum Company of America* v. *Sperry Products Inc.*, (1960) 285 F (2d) 911, 917. Certiorari Denied, 368 U. S. 890;

all of which fully supported its ruling and are contrary to the present decision of the Sixth Circuit. In all of these cases the Sixth Circuit Court of Appeals held patentable combination claims reciting *old* elements as well as new in which the old per se performed their old functions but in which the combination was improved.

In order to evaluate the effect of the decision of the Sixth Circuit, certain basic factors must be borne in mind. First, there was no basic combination in which the novel record dropping parts could be substituted in the place of the old prior art arrangements. There were cycling arrangements but these had to be modified to accept the novel arrangement of the present invention. Secondly, the novel record dropping parts had no useful function apart from their use in the recited combination. Patentees would not have been defining an operative structure unless cycling means was included as an element of the combination. Thirdly, the claim in question is more limited in scope as to what the claim will cover with the cycling means in-

cluded as an additional element of the combination. All elements of the recited combination must, of course, be found in an accused structure before infringement can be said to exist.

The present decision of the Sixth Circuit Court of Appeals is also in conflict with long-established tests of invention advanced by this Court. Where combination claims are at issue, this Court has consistently ruled that the combination as a whole determines the patentability. That one component of a combination claim is known to be old and performs, per se, its old function is not relevant to the issue of patentability. Instead, this Court has, where a combination claim comprises both old and new elements, required that the *whole* operate in an improved manner. This proper test was the basis for the ruling of validity in the present case by the District Court for the Northern District of Illinois (Conclusions of Law 14 and 20) and the District Court for the Western District of Michigan.

In *Williams Manufacturing Co.* v. *United Shoe Machinery Corporation*, 316 U. S. 364, this Court affirmed the Sixth Circuit Court of Appeals and observed with approval at page 367:

> "These findings are to the effect that the new combinations, while they involve old mechanical constructions, combine these in a new way so as to produce an improved result. These are findings of fact, despite the petitioner's apparent contention to the contrary, and we will not disturb such concurrent findings where, as here, there is evidence to support them. The claim that the combinations are merely of old elements, which perform no new function and produce no new results must be overruled."

There the majority of the Court faced squarely the problem posed in the present case since the defendant-infringer argued that the plaintiff had added parts to the combination as claimed. The Court said, in overruling such contentions, at page 369:

> "In describing the novel combinations embodied in the claims, it was necessary to make reference to certain portions of the machine in connection with which the new combinations were to operate and with which they were to dovetail, but, in mentioning these other mechanical parts, the claim does not purport to embody them as elements of the claimed combination. To construe such a claim for a combination of new elements intended to be embodied in some well recognized mechanical aggregation, such as a sewing machine or a washing machine, as a claim covering all the mechanical details, or all the well known parts of the machine, *would be to nullify every patent for an improvement in a type of machine long in use and would invalidate thousands of patents for improvements in standard machines.* It would be difficult to describe an improvement in a washing machine without naming such a machine as the thing to which the patent is addressed, and equally difficult to refrain from referring to various parts of the machine, such as the tub or the motor which actuates the washer. But it has never been thought that a claim limited to an improvement in some element of the machine is, by such reference, rendered bad as claiming a monopoly of tubs or motors used in washing machines." (Emphasis added.)

Claims 42 and 55, two of the claims there at issue, and considered illustrative, were set forth in footnotes at pages 377 and 379. They were in a form substantially identical to the claim here in suit.

The above ruling is by no means unique. It reflects the proper test and was promptly followed by the well known "Ray-O-Vac Case", *Goodyear Tire and Rubber Company, Inc., et al.* v. *Ray-O-Vac Company*, 321 U. S. 275 where

the Court held valid combination claims including the following claim 1:

> "A leak-immunized flashlight dry cell provided with circuit terminals at opposite ends, comprising: a hollow cylindrical zinc metal electrode containing electrolyte; a centrally disposed carbon electrode and depolarizing-mix in said electrolyte; a bottom closure for the cell affording a terminal for one of the electrodes; a top closure for the cell provided with a terminal for the other electrode, electrically insulated from the first mentioned terminal; and a protecting sheet-metal sheath insulated from both of said electrodes and enclosing the side walls of said metal electrode and tightly embracing said closures so as to prevent leakage of the electrolyte from the unit."

Manifestly the novel protecting sheet metal sheath recited here comprised only a part of the combination, and the old portions performed as always—but the overall result was a substantially improved patentable combination.

The claims held valid by the Supreme Court above clearly show that they contain numerous old elements operating, when considered *alone*, in the manner they had always operated. However, in the over-all combination, these parts dovetailed with new parts in a manner providing a new and improved result for the over-all patentable combination. In so doing, they comprised important inventions. It has been found in the Findings of Fact in the present case, that applicants achieved just that. The Sixth Circuit Court of Appeals is, however, promulgating a new doctrine of Patent Law designed to eliminate all such claims as those above set forth as the majority of the Court forewarned in *United Shoe Machinery Co.* case, supra.

Reference has hereinbefore been made to the fact that the Court of Appeals has disregarded certain treaty provisions which the United States has with Sweden. The basis for this assertion lies in the fact that the Court of

Appeals has predicated its decision at least in part on the alleged significance of what took place in the Swedish Patent Office during the prosecution of the corresponding Swedish application and on the alleged significance of the monopoly as represented by a Swedish patent. Such statements by the Court appear on pages 118, 119, 120 and 121 of its decision as reported in 325 F. (2d) 109, (Appendix 28, 29, 36, 41).

Now the United States and Sweden are parties to a treaty commonly known as the International Convention which provides in part:

> "H. Priority cannot be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims made in the application in the country of origin, provided that the application, as a whole, discloses precisely the aforesaid elements.
>
> "Article 4 *bis*.
>
> "(1) Patents applied for in the various countries of the Union by persons entitled to the benefits of the Union shall be independent of the patents obtained for the same invention in other countries, whether or not such countries be parties to the Union.
>
> "(2). This stipulation must receive a strict interpretation; in particular, it shall be understood to mean that patents applied for during the period of priority are independent, both as regards the grounds for refusal and revocation and as regards their normals duration." (53 Stat. 1768, 1774.)

When the disclosure of the foreign patent application, subsequently filed in the United States, supports the claims sought in the United States, then the United States applicant is entitled to them under R. S. 4887 (R. S. 4887, 49 Stat. 1529—now 35 U. S. C. 119), regardless of the claims granted in the foreign country. Under the statute, the United States application was entitled to

> "* * * have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention * * * *was first filed in such foreign country*: * * *" R. S. 4887. (Emphasis supplied.)

The Statute is specific. It makes the United States application retroactive to the date when the application disclosing the invention was *first* filed in Sweden. The filing of the divisional application thereafter in Sweden had no effect upon the United States rights, nor did it alter the disclosure.

The Court of Appeals of the Sixth Circuit has disregarded the treaty rights afforded subjects of Sweden by predicating any of its conclusions on what took place in the Swedish Patent Office after the original application was there filed. Furthermore, no evidence as to Swedish law was ever offered by the Defendant and the significance of the actual monopoly granted in Sweden can have no effect on the United States patent here involved. To do so violates the treaty rights above referred to. Defendant's Counsel so argued before District Court when reference was made to what had occurred in Canada. Specifically, Defendant's Counsel stated to the Court:

> "The patents in different countries are under the International Convention completely separate and a Canadian patent can expire or be held invalid and have no effect in the United States, and vice versa. Under treaties at the International Convention patents are independent in separate countries." (Appeal Record 6b.)
>
> "What these men may have done in Canada has no bearing on the United States whatever in respect of validity or infringement of the patent here in suit and we object that it is neither material nor relevant. In

* This was also the language of the statute when the patent was granted on July 28, 1942. The present language in 35 U. S. C. 119 is slightly different, but the meaning is the same.

fact it is incompetent to prove anything in this case". (Appeal Record 8b.)

Counsel for both parties agree as to this interpretation, but the Court of Appeals of the Sixth Circuit has disregarded the clear language of the treaty.

During the prosecution of the application which resulted in the patent in suit, the United States Patent Office ruled that application claim 27, later to become the claim in suit, was *incomplete* as having insufficient structure to provide record dropping (Physical Exhibit Px. F, page 54). The applicants were thus *required* to *add* structure, to provide a properly operative device. This requirement by the Patent Office was made notwithstanding the fact that it was familiar with and *had cited*, prior patents, showing cycling mechanisms as a component of many different types of record changing mechanisms. The Patent Office thus recognized that part of the claim in question included some old elements, including the cycling mechanism along with some new elements.

It is particularly significant to note that part of the more detailed description added following the examiner's requirement related to that portion of the claim describing the cycling component of the combination. The more specific description added included the last clauses of the claim in suit which read:

> "Means operative upon completion of the playing of a record for swinging said pick-up arm outwards, said means also rocking said lever into position disengaging said lowermost record, whereby the latter drops onto said turntable, and means for then returning the pick-up arm inwards to playing position." (Physical Exhibit Px. F, page 58).

Surely it is inequitable for the Sixth Circuit Court of Appeals now to say that having complied with the require-

ments of the Patent Office, the inventors cannot enjoy the fruits of their admitted contribution to the art. This is contrary to all principles of equity, and to the concept that in a Court of Equity, justice should be done.

CONCLUSION

It is respectfully suggested that the opinion of the Court of Appeals for the Sixth Circuit merits review by this Court for the reason that it sets forth a new test of invention for combination claims which is in conflict with decisions of this Court, in conflict with decisions of the Seventh Circuit, in conflict with prior decisions of the Sixth Circuit, and in conflict with the practice of the Patent Office. It also has predicated its conclusions in part on steps taken by the inventors in prosecuting certain applications in the Swedish Patent Office, contrary to the treaty rights provided for these men under the terms of the International Convention.

The decision of the Sixth Circuit Court of Appeals enunciates ungrounded principles, which, if not corrected, will destroy much of the protection now accorded to inventors of new and useful combinations pursuant to the United States Constitution.

Respectfully submitted,

DONALD J. SIMPSON,
LEWIS T. STEADMAN,
53 W. Jackson Blvd.,
Chicago 4, Illinois,
ROBERT G. HOWLETT,
Michigan Trust Bldg.,
Grand Rapids 2, Michigan,
Attorneys for Petitioners.

APPENDIX TO PETITION.

OPINION BELOW.

No. 14812 United States Court of Appeals, Sixth Circuit.

Before Miller and O'Sullivan, Circuit Judges, and William E. Miller, District Judge.

O'Sullivan, Circuit Judge.

This appeal involves the validity and charged infringement of United States Patent No. 2,291,158, issued on July 28, 1942, to A. H. Holstensson, as joint inventor with and assignee of, S. P. Arvidius. The claimed invention related to "talking machines for playing a plurality of records in succession." On November 4, 1954, Holstensson filed this action against defendant-appellant, V-M Corporation, a manufacturer of record players, charging its infringement of the claims of said patent. During the pendency of the action, plaintiff Holstensson assigned his rights in the patent to Glenville Industries, Inc., who thereafter prosecuted the action. Defendant denied infringement and for numerous reasons, some of which we discuss hereafter, charged that the patent was invalid. As the case was tried, only Claim No. 1 of the patent in suit was involved. The District Judge held that Claim No. 1 was valid and infringed by defendant. On July 28, 1959, the patent expired so that the relief sought is limited to damages allegedly suffered prior to the patent's expiration.

The patent in suit can be sustained, if at all, only as a patentable combination. Its Claim No. 1 and its specifications describe old art and previously patented subject matter. Plaintiff, however, asserts that some of the elements of Claim No. 1 are new and that their co-action with whatever is old in the total mechanism endows the

claim with validity as a patentable combination. The respective positions of the parties are partially exposed by defendant-appellant's Statement of Question Involved which reads:

> "Does the improvement of one part of an old combination give the right to claim, in a patent, that improvement in combination with other old parts which perform no new function in the combination?"

and by plaintiff-appellee's Counter-Statement, which reads:

> "Is the combination of mechanical elements defined by Claim 1 of Patent No. 2,291,158, certain elements of which are new, a patentable combination of elements rather than 'an old combination' of elements?"

In addition to its contention that the involved patent does not disclose a patentable combination, defendant asserts that it is void for overclaiming.

A. H. Holstensson and S. P. Arvidius were both residents and nationals of Sweden. Arvidius was an inventor and Holstensson a manufacturer. About 1934, Arvidius went to work for Holstensson. He invented a record player which, as early as 1934, was exhibited and marketed in Europe. He assigned his rights to such invention to Holstensson who obtained a patent therefor in Sweden on August 1st, 1936. The United States rights to this invention, however, were retained by Arvidius. On November 1, 1934, Arvidius applied for a U. S. patent therefor. He obtained an original patent on it in 1936, and a reissue thereof on August 9, 1938, (Reissue No. 20,819). In this opinion, we refer to such patent as the Arvidius patent.

This Arvidius patent described a record player which automatically accomplished the essential functions required for playing in succession and without manual intervention, a series of records. These functions were stated by the District Judge to be the dropping or placing of a record onto a turntable, the swinging of the arm, carrying

the needle, into playing position, the lowering of such arm, called the tone arm, to have the needle enter the grooves of a record, the playing of the record, the raising of the tone arm when the record has been played, the then swinging of it to the side so another record could be dropped onto the turntable and the automatic repetition of these operations until all of the records have been played. For our discussion, we combine and group all of these functions under two titles, viz: the record dropping mechanism and the cycling mechanism, the latter moving and controlling the cyclic movements of the tone arm.

In the Arvidius patent, the record dropping was accomplished by what was referred to as the "slicer" method. Oppositely disposed on either side of the turntable are two rotatable uprights (posts). On the top of each are two horizontal blades with a common pivot, but separated horizontally a distance equal to the thickness of a record. The records to be played are threaded over a central solid spindle and supported by having the outer edges of the lowermost record rest on the blades of the upright posts. When the tone arm has been swung to the side by the cycling mechanism, the lowermost record is dropped to the turntable by reciprocations of the slicer blades, releasing the lower record, but automatically reacting to restore support to the remaining unplayed records. A complex of gears, cams, pins, pinions, springs, etc., located on a base platform to the side of and below the turntable so cooperated that all functions were performed in cyclic sequences, the activation of the slicers occurring when the tone arm had been swung out of the way of the dropping record. Then began again the cycle wherein the tone arm is swung back to playing position at the edge of a new record, the record is played and the automatic movements continue to the next dropping of a record through the reciprocations of the slicers. The reciprocations of the slicers result from a "push-pull" move-

ment of a link located beneath the turntable, operating off of the cycling mechanism. This link is connected at its end to levers attached to the rotatable uprights, and by which they move to reciprocate the slicer blades. Such method of record dropping combined with the cycling mechanism to make up the Arvidius patent. The patent described an entire machine, with Figures 1 to 8, which comprehended both the record dropping and cycling mechanism. The inventor stated:

> "This invention relates to automatic gramophones of the kind in which a pile of records is supported centrally above a turntable, the records being dropped one at a time upon the turntable and played in succession.
>
> "The invention has for its object to provide an improved mechanism for effecting the necessary motions of the movable arm carrying the reproducing needle, and for actuating the means carrying the pile of records so as to cause a fresh record to be dropped upon the turntable after playing of each preceding record.
>
> "Further objects of the invention are to provide a mechanism of this character which is reliable in its operation and comparatively simple and inexpensive in its construction and which can be readily applied as an attachment, if desired, to existing gramophones of any conventional type.
>
> "With this and other objects in view, the invention consists in certain novel features of construction, combination and arrangement of parts as will fully appear as the description proceeds, the novel features thereof being pointed out in the appended claims."

The patent in suit, which we call the Holstensson patent, was applied for in 1938 by Holstensson and Arvidius as joint inventors. They described the device sought to be patented as a "Talking Machine for Playing a Plurality of Records." As to Claim 1 of the patent, our review of its language, the accompanying specifications and the evi-

dence received at the trial of this case, persuades us that it discloses the old Arvidius patent except as to the record supporting and dropping mechanism. In place of the old "slicer" method, the new application provided for the records to be supported above and dropped onto the turntable through the use of a central hollow spindle with an offset shoulder thereon in its upper portion and containing a lever so arranged and operated as to push the lowermost record off of the shoulder sideways so that its hole would engage the lower section of the spindle and drop to the turntable. When such displacement was completed, the lever, by spring action, moved back to its previous position, there to remain inactive until, at the proper time within the cycle, it was to drop another record. The lever contained within the hollow spindle extended, within said spindle, from where the latter was provided with the offset shoulder, down through the turntable where its lower end was connected to a link. When activated by, and operating off of, the cycling mechanism located below the turntable, this link, by a "push-pull" movement rocks the lever within the spindle to bring about the dropping of a record. This accomplished, the link and lever remain inactive while the tone arm, controlled by the cycling mechanism, goes through its cycling movements and it is again time to drop a record. Between the respective "push-pull" movements of the links which activate the record dropping both by the slicer and the spindle method, the record players described and patented by the old Arvidius patent and the Holstensson patent in suit bring about the automatic playing of records in the same way and by the same means.

This, then, is the lawsuit before us. A reissue patent granted on August 9, 1938, on an application made on November 1, 1934, describes and claims as its invention a record dropping mechanism and a cycling mechanism (the Arvidius patent). A second patent, applied for on

September 23, 1938, and issued on July 28, 1942, describes and claims as its inventions, a new record dropping mechanism, and also the same cycling mechanism covered by the previous patent. The record dropping mechanism of the respective patents cooperate with and are affected by the cycling mechanism in the same way in each patent. In the second patent (Holstensson patent in suit) the cycling mechanism is not identified either in Claim No. 1 or in the specifications as being old or previously patented, nor as part of a combination of old and new art. Two questions arise—first, is the second patent valid in its entirety as a combination patent and, second, is the second patent void in its entirety for overclaiming and as an attempt to claim and extend the monopoly of something already patented?

Claim 1 is the only claim of the Holstensson patent that is involved in this case. It reads:

> "In a talking machine, a rotatable hollow shaft, a turntable mounted on said shaft, a post extending through the shaft and having an upper extension which is offset with respect to the post to form thereon a shoulder for supporting a stack of records threaded on said extension, steadying means adapted to engage the upper side of said stack, said means being movable from said operative position to an inoperative position for permitting records to be threaded upon said extension, a lever pivotally mounted in said supporting post and having one end adapted to engage the edge of the central aperture of the lowermost record in said stack and to laterally displace said record to disengage it from said shoulder, a pickup arm mounted adjacent said turntable, means operative upon completion of the playing of a record for swinging said pickup arm outwards, said means also rocking said lever into position disengaging said lowermost record whereby the latter drops onto said turntable, and means for then returning the pickup arm inwards to playing position."

Claims 2 to 14 of the patent in suit have to do with mechanisms for the playing of various sized records and are not directly involved in this lawsuit. The claims and specifications of the old Arvidius patent did not comprehend a method or mechanism for automatic playing of records of different sizes, being limited to the then conventional ten inch records. Claims 2 to 14 of the patent in suit provide a way of playing larger records, as well as the smaller one. When a large record is displaced laterally by the rocking of the spindle lever, because of its size, it strikes a lever within a housing at the side of the turntable. When this latter lever is so activated by a large record, by a connection with the cycling mechanism, it so affects the movements thereof that the tone arm is caused to lower to the turntable at a point needed for playing the larger record. The defendant's machines are not charged with infringing these claims.

We here assume the patentability of the invention claimed by Arvidius in his original patent for a record player. His specifications and claims covered an entire machine, including the complex mechanism for lowering the needle-carrying tone arm onto the record, the playing of the record, the lifting and swinging of such arm out of the way when the record was played, the holding of such tone arm in an inoperative position for the time required for the employment of the "slicer" method of dropping the next record onto the turntable and then the repetition of the cycle.

The basic power for the operation of both the Arvidius and the Holstensson record players is provided by an electric motor which starts and continues the rotations of the turntable. In both machines, the cycling mechanism is set and continued in motion by the rotations of a small friction wheel which, at or near the end of the playing of a record, makes contact with the moving turntable, either

on the side thereof or on a ridge on its underside. The rotations of this friction wheel start and complete the movements of the gears, cams, pins, levers, etc., which make up the cycling mechanism common to both machines.

A record player made pursuant to the original Arvidius invention was marketed in Europe under the trade name of "Luxor." There is no evidence that a record player embodying the U. S. Arvidius patent was ever marketed or made in the United States by Arvidius, or by anyone else acting as his assignee or licensee. While the application for a reissue patent on this Arvidius machine was still pending in the United States, Arvidius, with Holstensson, went to work to create a record player which would in addition to what the old Luxor machine provided, contain means for automatic playing of records of different sizes. Such was not possible in the Arvidius (Luxor) machine. Out of this study came an application in Sweden for a patent. The initial application, filed in Sweden on September 23, 1937, disclosed that Holstensson and Arvidius, as inventors, had assigned their rights thereto to Holstensson's wife. In its specifications and drawing, this application described an entire machine, including a cycling mechanism substantially the same as that described in the Arvidius patent but specifying a new method for holding the records and dropping them on the turntable and providing for the playing of records of various sizes. This application contained some 16 drawings, Fig. 1-16. Following the filing on September 23, 1937, of such application which covered an entire machine, a further application was made on November 26, 1937, by Arvidius, alone, limiting its claims, specifications and drawings (Fig. 1-5, only) to the new spindle type record dropper and record supporting device. Its Figures 1-5 were identical with like numbered drawings in the first application covering an entire machine. The second application disclosed that, as inventor,

Arvidius had assigned his rights thereto to Holstensson's wife. The second application, limited to the record dropping mechanism, was made at the direction of the Patent Examiner in Sweden. On August 17, 1939, Swedish Patent No. 97,122 covering the entire machine, and Swedish Patent No. 97,123, limited to the spindle record dropper device, were issued, No. 97,122 to Holstensson and No. 97,123 to Holstensson's wife.

On September 23, 1938, Holstensson and Arvidius, as joint inventors, applied for the United States patent in suit, which was issued to Holstensson July 28th, 1942, as United States Patent No. 2,291,158. All rights to the invention claimed had been, as they were in Sweden, assigned by Arvidius to Holstensson. This application described an entire machine in substantially the same language and with the identical drawings, Fig. 1-16, as in Swedish Patent No. 97,122. It is agreed that the United States patent in suit is legally identical with the Swedish Patent No. 97,122. In their preliminary statement, the invetors said, in part:

> "The present invention relates to talking machines for playing a plurality of records in succession and more particularly to the type of such talking machines in which a stack of records to be played is supported above the turntable and a mechanism is provided which upon completion of the playing of a record automatically raises the arm carrying the sound box or pickup from said record, swings the same outwards, brings the next record in the stack to fall downwards to the turntable and move said arm back to a position for playing the new record.
>
> "The chief object of the present invention is to provide an improved talking machine of this general type which permits records of different sizes to be played automatically, i.e., in which the stack of records supported above the turntable may contain records of different diameters indiscriminately mixed."

While the above does not emphasize, as within the chief objectives of the patent, the use of the spindle type record changer, the specifications completely describes it, as well as the cycling mechanism, and the means for steadying the stack of records. We consider it unnecessary to discuss this steadying device, which may or may not have any inventive quality. Nowhere in the specifications or in Claim No. 1 is there a suggestion that the cycling mechanism was old or that it had been disclosed in the previous Arvidius patent.

From our examination of the models of machines constructed to portray the Holstensson patent in suit and the Arvidius patent, from the testimony of plaintiffs' expert witness, one Fishleigh, and from consideration of the entire record, we are persuaded that the cycling mechanism of the Holstensson and Arvidius patents are the same. Plaintiffs introduced as their Exhibit K a record playing machine constructed in accordance with the patent in suit. By demonstration, it was shown that with the spindle type record dropper and the record steadying means of the patent in suit removed, the cycling mechanism went through all of its various movements. Such demonstration was followed by this cross-examination of plaintiffs' expert, Fishleigh.

> "Q. This machine (Ex. K) just performed the operation of automatically lifting the tone arm when the tone arm had arrived at a certain portion at the inner end of the playing groove, and if automatically moved out beyond the edge of the table (turntable) and then paused, and then moved in to the table (turntable) in register with the outer edge of the record, and then lowered the tone arm needle down onto the record automatically, isn't that correct?
>
> "A. That is correct.
>
> "Q. Showing that that mechanism is not dependent upon the presence of any mechanical record supporting and dropping means?

"A. You mean so that that mechanism does not stop if we disconnect the record dropping means? That certainly is correct.

"Q. Mr. Dienner: Read my question. I would like to have an answer to the question directly.

(question read)

"Q. Yes?

"A. Oh, I think that is correct.

* * *

"Q. Mr. Fishleigh, we have just operated the machine, Defendant's Exhibit K, without the step spindle to show that the mechanism will, upon the end of the playing of the record, when the tone arm arrives at a definite position, cause the mechanism to lift the tone arm needle from the record, move the tone arm out beyond the edge of the record, pause, and return and drop the needle onto the edge of the record for the playing of that record that is on the turntable, that is correct, isn't it?

"A. It did so operate, yes, sir.

"Q. Now, the Arvidius reissue patent (Arvidius) has elements which correspond to the elements of Exhibit K if we disregard the record supporting and dropping means, isn't that correct?

"A. I think in general, generally so, yes.

* * *

"Q. Returning to the patent in suit, the last elements of Claim 1 is 'and means for then returning the pickup arm inwards to playing position.' We have not discussed that specifically, but that refers to the moon-shaped cam, does it not, in the Holstensson patent designated by the reference numeral 69?

"A. That is a part of that. The moon-shaped cam is part of that element, yes, sir.

"Q. And in the Arvidius reissue patent there is a similar moon-shaped cam 30-31 which performs the same functions of returning the tone arm inwards?

"A. Well, there is a somowhat similar and different detailed cam, part of which does function too along with other elements to return the pickup arm inwards, that is correct.

"Q. And after the initiating mechanism starts the cam wheel into operation in the Holstensson patent, the cam wheel is 66 in Holstensson patent, is it not?

"A. Yes.

"Q. And there is a similar cam wheel? I believe it is 48-27 in the Arvidius reissue patent.

"A. Well, I think that is true. I believe that the comparison would be closer between 66 in the Holstensson patent in suit, if my memory serves me right, and 48 in the reissue patent, but they both have gear members to which the cams are attached.

"Q. The cam for raising and lowering the tone arm through the operation of the pin 56 in Holstensson is found in the Arvidius as a similar cam in the gear wheel 27 for raising and lowering the tone arm in the Arvidius structure through the pin 25, isn't that correct?

"A. That is correct.

"Q. And the surrounding sleeve around that pin 25 in Arvidius reissue corresponds to the surrounding sleeve 55 in Figure 7 of the Holstensson, et al. patent in suit?

"A. It is quite similar in its operation, yes.

"Q. And the half-moon cam 31-32 of Arvidius co-operates with the pin 32 in Arvidius as the cam—half-moon cam 69 operates with the pin 70 in Holsfensson?

"A. In part, yes, sir.

"Q. So that the tone arm is moved first out by contacting the right hand or upper portion 31 in Arvidius by the pin 32, is that correct?

"A. Yes.

"Q. And likewise contacting the right hand or upper arm of the half-moon cam by the pin 70 in the patent in suit?

"A. That is correct.

"Q. And the return of the tone arm in the Arvidius is performed by the pin 32 engaging the arm 30 of the moon-shaped cam, and in Holstensson the return of the tone arm is performed by the engagement of the pin 70 with the left hand or lower limb of the moon-shaped cam, is it not?

"A. That is correct.

"Q. So that we find complete correspondence in the operating cams and pins in these two patents, do we not?

"A. No, sir. To the extent that you have defined it so far, speaking generally that is true, but I could not agree that there is complete correspondence because there is considerably more in Holstensson that we have not discussed.

"Q. But not in the parts that we have discussed, is there, just now?

"The Court: The witness has said as to the parts which you have discussed he agrees there is correspondence, is that right?

"The Witness: That is correct, sir.

* * *

"Q. Certainly in respect to Arvidius 20,819 which is shown in these drawings, Defendant's Exhibits 1, 2, 3 and 4, there is that means operative upon completion of the playing of a record for swinging said pickup arm outwards?

"A. I think that is correct.

"Q. And there is then a disclosure of the patent in suit of the corresponding means?

"A. I think that is correct; there is a means differing in some detail, yes.

"Q. And what detail, what difference is there between the two?

"A. Well, primarily in the detail of the cam mechanism. Broadly speaking, I think they are the same, but in detail they are not exactly identical.

"Q. Well, there is no doubt about the fact that there is such means present in the patent in suit.

"A. Not in my mind, no, sir."

After some examination of this witness as to the detail of the cycling mechanism disclosed in the Holstensson patent in suit and in the Arvidius patent, such examination continued:

"Q. So that we find complete correspondence in the

operating cams and pins in these two patents, do we not?

"A. No, sir. To the extent that you have defined it so far, speaking generally that is true, but I could not agree that there is complete correspondence because there is considerably more in Holstensson that we have not discussed.

"Q. But not in the parts that we have discussed, is there, just now?

"The Court: The Witness has said as to the parts which you have discussed he agrees there is correspondence, is that right?

"The Witness: That is correct, sir.

"The Court: All right.

"The Witness: The operation as far as you have gone.

"The Court: The next question was whether there was complete correspondence between the two units and he disagreed with that, is that right, sir?

"The Witness: That is my position, yes.

"Q. By Mr. Dienner: And the disagreement is based on what?

"A. Well, the fact that there are two parts to the operation of returning the tone arm to the initial position in the Holstensson and the action of the pin 70 which we do not have in pivoting about, well the arm 71 pivoting about a pivot point at the back end under certain conditions of cycling.

"The Court: Are you now referring to the Holstensson patent?

"The Witness: That is correct.

"Q. Mr. Dienner: Are those differences involved in the statement of Claim 1 of the patent in suit?

"A. I don't think so, no."

Continuing on, we believe that plaintiffs' expert effectually conceded the identity of the operations of the cycling mechanism in the Holstensson and Arvidius patents down to the time when, at the final step of the cycle, a link beneath the turntable, in each patent, makes its move to

activate the record dropping mechanism. This examination concluded the subject:

"Q. And the operation of a record dropping means through a link is performed in Arvidius by the engagement of the dotted pin 53 in Fig. 5 against the link 11 which we mentioned earlier in our examination?

"A. That is correct.

"Q. And the operation of a link 91 in the Holstensson patent in suit is produced by pin 98 riding off the shoulder 101 in Fig. 10 is it not?

"A. I think that is correct.

"Q. So those two structures correspond in structure and mode of operation and result, do they not?

"A. I don't think I could even begin to go along with you on that one, sir.

"Q. They move a link back and forth in proper time, do they not?

"A. That is correct."

Defendant's expert witness Faulkner was, as might be expected, more firm in his assertion that the cycling mechanism of Holstensson and Arvidius were substantially the same. He gave support to this assertion by taking a model of the old Luxor machine built on the Arvidius patent but with the old slicer record dropping mechanism removed; to the link which had activated the rotatable posts and the slicers, he attached in place thereof, the spindle type record dropper of the Holstensson patent in suit. This reconstructed machine then operated the same as the machine built on the patent in suit. In our view, this demonstration supported defendant's claim that the cycling mechanisms of Holstensson and Arvidius were the same, and that the new spindle mechanism in no way changed the function or operation of the cycling mechanism and that the latter, as contained in the patent in suit, made no different contribution of function to record dropping than it had in the old Arvidius machine.

The inventor, or inventors, of the patent in suit provided further evidence that the spindle type record dropper was a separate invention, independent of the cycling mechanism, by applying for and obtaining separate Swedish Patent No. 97,123, limited to the spindle type record dropper and supporting device. As to the cycling mechanism of the tone arm and its activation of the record dropper, the inventor in 97,123 said:

> "The movements of the tone arm, as well as the record changing operation, are controlled by a cam mechanism *not illustrated*, mounted on the underside of the base plate below the tone arm and preferably arranged to be operated from the turntable 3 through a friction roller 58 protruding upwards through a hole 57 of the base plate, although of course, other operating methods are conceivable too."

The claims of this Swedish patent, 97,123, did not attempt to claim the cycling mechanism as any part of the invention, independently of, or in combination with, the spindle type record dropper and record supporting means. Conversely, the Holstensson patent in suit in its Claim No. 1 and its specifications, and the Swedish patent No. 97,122 describe and claim as invention the cycling mechanism as well as the new spindle.

From all of the foregoing, we are persuaded first that the cycling mechanism of the patent in suit was previously disclosed in the Arvidius patent and, second, that the cycling mechanism redescribed and claimed as invention in Claim 1 of the patent in suit, performs no new function when combined with the spindle type record dropper. The District Judge found invention in the spindle type record dropper. Appellant does not here contest the presence of

invention in the spindle device, nor the charge of infringement.[1] We need not, therefore, consider such matter.

The District Judge made no finding of fact or law as to whether the cycling mechanism of the Holstensson patent in suit was the same as, or had been disclosed in, the earlier Arvidius patent. He apparently did not consider such a finding necessary for decision. He said:

> "[T]he fundamental mechanical means used below the turntable for the activation of the tone arm and of the turntable, and for placing of the record *are of no consequence to the determination of this lawsuit.* The basic problem is whether the center hollow spindle of the defendant's device, following the teaching of the Miller patent, is an infringement upon the plaintiff's patent in suit." (Emphasis supplied.)

Throughout the trial of this case and in this Court, plaintiffs' position has been that their patent combines new invention with *old elements.* No clear expression, however, is made as to what are these *old elements* referred to. We think it fair to conclude that the cycling mechanism of the old Arvidius patent comprises, or is at least one of the *old elements.* The District Judge's opinion says,

> "[W]e should say that we have examined the combination patent in suit * * * and are satisfied that the combination patented by Holstensson is a combination of *old elements* with *a new element* whereby a new result is obtained * * *." (Emphasis supplied.)

We are of the opinion that from the evidence no other

[1] The use of a spindle with an offset shoulder to support a stack of records and a method for laterally displacing them so that the central aperture would engage the lower section of such spindle and drop to the turntable were not new and had been disclosed in the prior art. None however employed the hollow spindle enclosing a lever which was activated from beneath the turntable. The District Judge found that the advance of the Holstensson spindle over the prior art would not have been obvious to one skilled in the art. That finding is not contested on this appeal.

conclusion could be drawn but that the cycling mechanism claimed as invention in, and described in, the patent in suit was the same as that disclosed by the Arvidius patent. Any finding of fact to the contrary would, in our opinion, be clearly erroneous.

Although the Holstensson patent in suit was issued in 1942, neither the patentee nor any assignee thereof or licensee thereunder, prior to 1950, used the same in any marketed record playing machine. In 1950 defendant V-M Corporation began to market a machine with a spindle type record dropper conforming to a Miller patent therefor issued on September 19, 1950, on an application made in 1940. The Miller patent was limited in its claim of invention to a spindle type record changer. After defendant, in 1950, made the first use of a spindle type record dropper in a marketed machine, record players using the spindle type of record changer have enjoyed the largest commercial success. Another company, Webcor, Inc., began using a spindle type record dropper and upon suit by Holstensson, was found guilty of infringing the Holstensson patent in suit. In such, District Judge Perry held that the patent in suit was valid. *Holstensson* v. *Webcor, Inc.*, 150 F. Supp. 441, 112 USPQ 463 (N. D. Ill. 1957). This suit was filed on November 8, 1954, and the instant suit was filed November 4, 1954. In 1954, and subsequent years, various manufacturers took from Holstensson or Glenville Industries licenses to use the Holstensson patent in suit. At the time of trial in 1959, defendant V-M Corporation was the only American manufacturer using the accused type of spindle without license from Holstensson or Glenville Industries.

In the District Court, defendant challenged the validity of the patent in suit on the grounds that the spindle type record dropper did not contain invention, that it had been disclosed in the prior art, and that whatever advance or

improvement was made in the spindle record dropper over the prior art was such as would have been obvious to one skilled in the art. The District Judge found against these contentions and defendant does not here assert error in such findings. Defendant also claimed in the District Court, as it does here, that the product of Holstensson's putting together the new spindle type record dropper with the cycling mechanism already disclosed in the Arvidius patent did not constitute a patentable combination. Defendant asserts that the old Arvidius cycling mechanism performs no new function in the claimed combination and contributes nothing new to the operation of the record dropping mechanism. Defendant further asserts, as he did in the District Court, that the patent in suit is void for overclaiming that Holstensson attempted by the means employed, and as assignee of Arvidius, to obtain and extend the monopoly of the cycling mechanism disclosed in the old Arvidius patent. We are persuaded that the Holstensson patent in suit cannot be sustained as a combination and we are of the opinion that it is void for overclaiming.

A reading of the testimony of A. H. Holstensson, given through an interpreter, leaves the impression that he really was not *jointly* an inventor with Arvidius, although described as such in the joint application for the patent in suit.[2] We need not, and do not, however, make any finding in this regard. It appears, also, that Arvidius provided most, if not all, of the inventive genius that produced whatever patentability resides in the several devices controlled by Holstensson. In each instance but one, Arvidius had

[2] Arvidius was the sole inventor of the old Luxor machine with a cycling mechanism the same as the patent in suit. He was also named as sole inventor in the Swedish Patent No. 97,123, limited to the spindle type record dropper. Holstensson testified to working with Arvidius in the development of the latter, but said he gave Arvidius "the honor" of such invention.

assigned the rights to his invention either to Holstensson or to Holstensson's wife when applications for patents on such inventions were made. The one exception involved the United States patent rights to Arvidius original invention. Arvidius chose to retain the American rights to this and obtained the Arvidius reissue patent which covered the cycling mechanism and his slicer method of record dropping. The evidence discloses that after joining Holstensson in the application for the United States patent in suit in September, 1938, and presumably after assigning his rights therein to Holstensson, some time about the year 1939, Arvidius was discharged from his employment with the Holstensson enterprises. He was then, and thereafter, the sole owner of the United States patent for the cycling mechanism disclosed in Arvidius reissue patent. The record in the case gives no history of Arvidius after being discharged by Holstensson's enterprise other than that he was dead at the time of trial. Decision of this case involves the subjects of patentable combinations and invalidity of a patent for overclaiming. Much has been written on the first point, less on the second. We find difficulty in separate discussion of them in the context of the case at bar.

1. Patentable Combination.

No statutes or decided cases give us a definition of patentable combination which will provide easy discernment of its presence or absence in the limitless varieties of putting together the old with the old and old with the new. In *Great A & P Tea Co. v. Supermarket Equip. Corp.*, 340 U. S. 147, 150, 95 L. Ed. 162, 166 87 USPQ 303, 305, the Supreme Court emphasizes that it had never ventured to give "a precise and comprehensive definition of the test to be applied in such cases." In the case at bar, one of the elements, the spindle type record dropper was new and constituted invention. This invention was combined with

another element, the cycling mechanism, which was old and disclosed in the Arvidius patent. We, therefore, deal with a combination which brings together the new and the old. Such combinations have been held patentable as such, *Williams Mfg. Co.* v. *United Shoe Mach. Corp.*, 316 U. S. 364, 86 L. Ed. 1537, 53 USPQ 478; *Leeds & Co.* v. *Victor Talking Mach. Co.*, 213 U. S. 301, 53 L. Ed. 805. But to be so it is necessary that the old contribute something more than mere presence, to the functioning, the utility and the novelty claimed to provide patentability for the total combination. *Lincoln Eng'r Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545, 549, 82 L. Ed. 1008, 1010, 37 USPQ 1, 3; *DeBurgh* v. *Kindel Furniture Co.*, 125 F. Supp. 468, 476, 103 USPQ 203, 208-209, affirmed, *DeBurgh* v. *Kindel Furniture Co.*, 229 F. 2d 740, 109 USPQ 27 (CA 6, 1956), 1 Walker, Patents, § 41 (Deller ed. 1937). We feel that what was sought to be done with the new spindle type record dropper here was, not unlike the Supreme Court's characterization of the inventor's conduct in Lincoln Engineering—"having hit upon the improvement he did not patent it as such but attempted to claim it in combination with other elements which performed no new function in his claimed combination." (303 U. S. 549, 82 L. Ed. 1010, 37 USPQ at 3).

We think that from the concessions of plaintiffs' expert, from our own examination of the patent in suit, and from the fact that the inventors in obtaining Swedish Patent No. 97,123, recognized that their invention over the old Arvidius device resided only in the spindle device, it is fair to say that the old Arvidius cycling mechanism, claimed again in Claim No. 1 of the patent in suit, contributed no more to the operation of the claimed combination than the electric motor which provided the power for rotating the turntable. We recognize that the cycling mechanism, insofar as it cooperates with the method for playing records of dif-

ferent sizes, may, with new attachments not shown in the old Arvidins mechanism, do so, but Claim 1 here involved has nothing to do with a method for playing different size records.

The claims are the measure of invention. *Smith v. Snow*, 294 U. S. 1, 11, 79 L. Ed. 721, 728, 24 USPQ 26, 30; *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405, 418, 32 L. Ed. 1122, 1128; *Patrol Valve Co. v. Robertshaw-Fulton Controls Co.*, 210 F. 2d 146, 152, 100 USPQ 239, 243.

We hold that Claim 1 does not disclose a patentable combination.

2. Is Claim 1 Void for Overclaiming?

We think a fair review of the language of Claim No. 1, set out above, discloses the inventor's intention to claim the cycling mechanism as part of the invention, combination or otherwise. While the spindle type record dropper is described with more particularity than the cycling mechanism, and the cycling movements of the tone arm are, in part, referred to as means, the specifications illustrated with drawings (Figs. 1-16) cover the entire operation. Plaintiffs' expert testified that Claim No. 1 describes a machine which includes the cycling mechanism. Plaintiffs' complaint did not limit its charge of infringement to use by defendant of the spindle type record dropper. Plaintiffs' proofs were directed at showing that the cycling mechanism used in defendant's models infringed on the cycling mechanism as well as the spindle. Nowhere in the entire patent, including its specifications and drawings, is there any disclosure that the described cycling mechanism was old and previously disclosed in prior patent, and Claim No. 1 does not purport to be a combination of something

new with old prior art.[3] At the beginning of the trial, it was stated by plaintiffs' counsel that "* * * Claim No. 1 of the patent that is here in suit is directed to the broad basic combination." A member of the public, reading Claim No. 1 and all the specifications, would not be informed that the cycling mechanism was other than an original invention. That plaintiffs' position was to claim this cycling mechanism as invention in the patent in suit is made clear by one of their main exhibits entitled "Chart Showing Wherein Mechanical Elements of Claim 1 of Holstensson, et al., Patent No. 2,219,158 are Found in Defendant's Structure." The drawings depict figures of the patent in suit and similarly functioning elements of defendant's accused device. By this exhibit, it was claimed that among the "Mechanical Elements" of the patent in suit were "a pickup arm mounted adjacent said turntable," "means operative upon completion of the playing of a record for swinging said pickup arm outwards," and "means (after a record is dropped) for then returning the pickup arm inwards to playing position." While not complete in detailed description, this exhibit purports to show not only wherein the accused device has appropriated the spindle type record dropper, but also the method of carrying out the cyclic movements of the tone arm.

Plaintiffs rely in part upon the rule that a presumption of a patent's validity arises from its issuance. 35 U. S. C. A. § 282; *RCA* v. *Radio Eng'r Labs. Inc.*, 293 U. S. 1, 79 L. Ed. 163, 21 USPQ 353, and cases cited therein.

[3] At one point in the specifications, it is stated that "upon completion of the playing the cam mechanism is put into action by means of a device which is *not shown in the drawing* * * *." This is followed by a statement that "This mechanism which is known per se forms no part of the present invention." While we find obscurity in this statement, it is clear that the mechanism referred to is not the cycling mechanism of the old Arvidius patent because the latter is fully described and illustrated and what is conceded to be previous invention is not shown.

This presumption is weakened if there is applicable prior art not considered by the Patent Office. *ALCO A v. Sperry Products Inc.*, 285 F. 2d 911, 916, 127 USPQ 394, 399 (CA 6, 1960); *France Mfg. Co. v. Jefferson Elec. Co.*, 6 Cir., 106 F. 2d 605, 43 USPQ 53; *Wolverine Fabricating & Mfg. Co., Inc. v. Detroit Gasket & Mfg. Co.*, 6 Cir., 148 F. 2d 399, 65 USPQ 208; *Modern Products Supply Co. v. Drachenberg*, 6 Cir., 152 F. 2d 203, 68 USPQ 10; *Cold Metal Process Co. v. Republic Steel Corp.*, 6 Cir., 233 F. 2d 828, 109 USPQ 185; *Gibson Stewart Co., Inc. v. Wm. Bros. Boiler & Manufacturing Company*, 6 Cir., 264 F. 2d 776, 120 USPQ 352; *Murray Company of Texas, Inc. v. Continental Gin Co.*, 5 Cir., 264 F. 2d 65, 120 USPQ 416. The Arvidius patent (Arvidius reissue No. 20,819) was not cited and apparently not considered by the patent examiner. Plaintiffs argue that the prior art which was considered by the Patent Office (patents relating primarily to spindle type record droppers) was more pertinent than the Arvidius patent. This would be true if the claim of the applicants for the patent in suit was directed only at the spindle type record dropper. If, as is this case, the cycling mechanism was part of the invention claimed, then, indeed, Arvidius Reissue No. 20,819 was pertinent prior art. No reason is given as to why it was not cited in the Patent Office.

We come, finally, to the critical question for our decision, namely, will the owner of a patent which, in part, contains patentable invention, be denied recovery from one who clearly infringes the part of the patent which is invention, merely because the patent is not a true combination and claims as part of the invention that which is old and disclosed in a prior patent? We are of the opinion that we must answer in the affirmative. Such a holding appears unfair unless there is a policy of patent law which, in its effect, visits total forfeiture upon a patent which at-

tempts to extend its monopoly to something already patented. There is such a policy.

The modern cases most cited for this proposition are *Bassick Mfg. Co.* v. *R. M. Hollingshead Co.*, 298 U. S. 415, 80 L. Ed. 1254, 29 USPQ 311, and *Lincoln Eng'r Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545, 82 L. Ed. 1008, 37 USPQ 1. In Bassick the Supreme Court, speaking of claiming the old with the new, not in true combination, said:

> "The question then is whether, by this method, the patentee by improving one element of an old combination whose construction and operation are otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element. *That this cannot be done is shown by numerous cases in this and other federal courts.*" (Emphasis added) (303 U. S. 425, 80 L. Ed. 1256, 29 USPQ at 315).

In Lincoln Engineering, the Supreme Court said:

> "As we said of Gullborg in the *Rogers* case, having hit upon this improvement he did not patent it as such but attempted to claim it in combination with other old elements which performed no new function in his claimed combination. *The patent is therefore void as claiming more than the applicant invented.* * * * and the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination." (Emphasis added) (303 U. S. 5[illegible], 82 L. Ed. 1010, 37 USPQ at 3).

While the quoted passages from Bassick and Lincoln Engineering are broad in their support of a policy of declaring void a patent for overclaiming, they must be read in their factual context. Each of these cases involved contributory infringement. There, the accused devices were not charged with infringing new elements in claimed combination patents, but with manufacturing components, old

in the art, which were to be sold for use with new elements in the patentees' claimed combinations. Such is not the case before us where defendant is found to infringe the new element of the patent in suit. The principle of those cases is, however, applicable.

In *Great A & P Tea Co. v. Supermarket Equip. Corp.*, 340 U. S. 147, 95 L. Ed. 162, 87 USPQ 303, the Supreme Court was considering the patentability of a combination for a cashier's counter in a supermarket. The components were an elongated L shaped counter, a three sided open end rack for pulling groceries up to the cashier, and guides on the counter to control the rack. The Court held the combination was not patentable, but considering that the extension of the counter might be a patentable improvement, said:

> "* * * if the extension itself were conceded to be a patentable improvement of the counter and the claims were construed to include it, the patent would nevertheless be invalid for overclaiming the invention by including old elements unless, together with its other old elements, the extension made up a new combination patentable as such." (340 U. S. 149, 95 L. Ed. 165, 87 USPQ 305).

Without citing or attempting review of the many cases which have dealt generally with the subject of overclaiming, we come to *Evans* v. *Eatons*, 20 U. S. 356, 5 L. Ed. 472 (1822). Unless changes in statutory language or the holdings of later decisions impair this case's standing as announcing a rule of law, we consider that it impels us to hold the Holstenssön patent in suit void. The patent there involved related to a so-called "Hopper Boy," a machine involving "the art of manufacturing flour and meal." Evans invented an improvement to the "Hopper Boy," a mechanism known in such art. Two decisions, the one above cited and *Evans* v. *Eaton*, 16 U. S. 454, 4 L. Ed. 433,

discuss at length the factual background of the case as well as the statutes then in force. Understanding of the import of this decision can be adequately gained, however, from the court's recitation of the question involved. The plaintiff's action for infringment had been tried to a jury and, after reading the trial court's charge, Mr. Justice Story stated:

> "The plaintiff, with a view to the maintenance of his suit, contended that his patent, so far as respected the hopper-boy, had a double aspect. 1. That it was to be as a patent for the whole of the improved hopper-boy: that is, of the whole machine as his own invention. 2. That if not susceptible of this construction, it was for an improvement upon the hopper-boy, and he was entitled to recover against the defendant for using his improvement. The defendant admitted that he used the improved hopper-boy, and put his defense upon two grounds: 1. That if the patent was for the whole machine, i.e., the improved hopper-boy, the plaintiff was not the inventor of the improved hopper-boy so patented. 2. That if the patent was for an improvement only upon the hopper-boy, the specification did not describe the nature and extent of the improvement; and if it did, still the patent comprehended the whole machine, and was broader than the invention." (20 U.S. 427, 428, 5 L. Ed. 490).

The legal question thus exposed, and after reviewing the requirements of the then controlling patent law, the Court said:

> "From this enumeration of the provisions of the act, it is clear that the party cannot entitle himself to a patent for more than his own invention; and if his patent includes things before known, or before in use, as his invention, he is not entitled to recover, for his patent is broader than his invention. If, therefore, the patent be for the whole of a machine, the party can maintain a title to it only by establishing that it is substantially new in its structure and mode of oper-

> ation. If the same combination existed before in machines of the same nature, up to a certain point, and the party's invention consists, in adding some new machinery, or some improved mode of operation to the old, the patent should be limited to such improvement, for, if it, includes the whole machinery, it includes more than his invention and therefore cannot be supported. This is the view of the law on this point which was taken by the Circuit Court." (20 U. S. 430, 431, 5 L. Ed. 491).

In stating what he claimed was his invention, the patentee had said:

> "I claim as my invention, the peculiar properties or principles which this machine possesses in the spreading, turning and gathering the meal at one operation and the raising and lowering of its arms by its motion, to accomodate itself to any quantity of meal it has to operate upon." (20 U. S. 428, 5 L. Ed. 490).

Of this manner of stating the patentee's claim, Mr. Justice Story said:

> "From this manner of stating his invention, without any other qualification, it is apparent that it is just such a claim as would be made use of by the plaintiff, if the whole machine was substantially in its structure and combinations new. The plaintiff does not state it to be a specific improvement upon an existing machine, confining his claim to that improvement, but as an invention substantially original. In short, he claims the machine as substantially new in its properties and principles, that is to say, in the modus operandi." (20 U. S. 428, 5 L. Ed. 490).

The Court in holding the patent there involved to be invalid, relied upon the patent law then in force which required the applicant for a patent to describe it "in such full, clear and distinct terms as to distinguish the same

from all other things before known."[4] Applying such requirement, the Court said, "how can that be a sufficient specification of an improvement in a machine which does not distinguish what the improvement is, nor state in what it consists, nor how far the invention extends? Which describes the machine fully and accurately as a whole, mixing up the new and old, but does not in the slightest degree explain what is the nature or limit of the improvement which the party claims as his own?" The decision of the case was affirmance of a Circuit Court judgment, through approval of the trial judge's instructions which announced the rule of law discussed by the Supreme Court and approved by it.

While not citing *Evans* v. *Eaton*, its rule is followed in other cases which emphasize the requirement that an applicant for an improvement or combination must particularize as to what is old and what is new. *Merrill* v. *Yeomans*, 94 U. S. 568, 24 L. Ed. 235; *Brooks* v. *Fiske*, 56 U. S. 212, 214, 14 L. Ed. 665, 667. In *Patrol Valve Co.* v. *Robertshaw Fulton Controls Co.*, *supra*, Judge McAllister speaking for this Court, said:

> "[W]e are of the opinion that the claims of the patent in suit *are invalid* for the reason that the patentees do not particularly point out and distinctly claim the part, improvement, or combination which they claim as their invention or discovery, as required by the

[4] The language of the Act in force at the time of the issuance of the patent in suit was not identical with that quoted in the Evans opinion. We consider, however, that the Act in force when the Holstensson patent in suit was applied for was of like import. § 33 of Title 35 U. S. C. (repealed in 1953) required that the applicant for a patent so describe his invention "so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, the improvement, or combination which he claims as his invention or discovery."

> controlling statute, R. S. § 4888, 35 U. S. C. A. § 33." (210 F. 2d 150, 100 USPQ at 242, CA 6, 1954).

In *Williams* v. *United Shoe Mach. Corp.*, 121 F. 2d 273, 279, 50 USPQ 264, 271 (CA 6, 1941), we said, in holding one of the involved patents invalid, "[W]hatever improvement may result is due entirely to the improved element *and cannot give rise* to valid claims embracing the entire lasting mechanism" (Emphasis supplied).

It might appear unfair to deny an inventor the fruits of his invention merely because he overclaimed its breadth in his patent application and unjust to allow a third party to appropriate and infringe a true invention because of the failure of a patentee to comply with the patent statute. This might be arguable unless we look upon *Evans* v. *Eaton* as announcing a policy which, correctly applied, may visit forfeiture of a patent even though it, in part, discloses true invention. That such is the thrust of the majority opinion in Evans is exposed by its dissenting opinion which decries the severity of the rule of the majority opinion. The dissenter observes:

> "To declare a patent for a highly useful improvement, absolutely void, merely for a defective specification, if this be one, is a very high penalty, and should not be lightly inflicted unless rendered absolutely necessary by law" (20 U. S. 448, 5 L. Ed. 495).

In contemplating this seemingly drastic rule, we bear in mind that there is no natural or common law right to a monopoly of an invention. *Robinson Treatise on the Law of Patents* (1890), § 24. By Constitutional grant, Article I, § 8, Clause 8, Congress has power to give inventors, for a limited time, "the exclusive right to their respective

§ 171 of the current Rules of Practice of the U. S. Patent Office emphasize the necessity of clear identification of the old and the new in providing that "the specifications must set forth the precise invention * * * in such manner as to distinguish it from other inventions *and from what is old*" (37 C. F. R. § 171(a)).

discoveries." Applicants for such monopolies must comply with the requirements that Congress insists by met as a condition to exercising such monopoly. The seeming harshness of this rule is further ameliorated when we keep in mind that an inventor may gain monopoly for an inventive improvement to an existing device simply by limiting his claim to that which he did invent. In the case before us, this could have been accomplished by a narrowing of Claim 1, or by presentation of a separate claim limited to the spindle type record dropper which, for this opinion, it is assumed presented invention. In Sweden, Holstensson did this. Swedish patent No. 97,122 was taken out on the entire machine, while patent No. 97,123 was limited to the spindle record dropper. The same procedure could have been followed here, but was not.

Evans v. *Eaton*, which controls this case, does not appear to have been cited or relied upon for the point here involved in any recent decision of the Supreme Court; neither has it been overruled or criticized. It has currency as authority, however, in decisions of District Courts and Courts of Appeals. *Guide* v. *Desperak*, 144 F. Supp. 182, 111 USPQ 32 (S. D. N. Y. 1956); *Jacobs Mfg. Co.* v. *Almond Mfg. Co.*, 177 F. 935, 936; *Wheeler* v. *James*, 189 F. 896, 902; *National Mach. Corp., Inc.* v. *Bonthall Mach. Co.*, 241 F. 72, 87; *Brooks Co.* v. *Stoffel Seals Corp.*, 160 F. Supp. 581, 592, 417 USPQ 91, 99 (S. D. N. Y. 1958); *Porsche* v. *Atlas Scraper and Eng'r Co.*, 300 F. 2d 467, 477, 132 USPQ 104, 112 (CA 9, 1961). We think that while the *Bassick*, *Lincoln Engineering* and the *A & P* cases, discussed above, do not cite *Evans* v. *Eaton*, they follow the law it announced. So also do *Cold Metal Process Co.* v. *Republic Steel Corp.*, 233 F. 2d 828, 834, 109 USPQ 185, 189 (CA 6, 1956); *Graver Tank & Mfg. Co.* v. *Linde Products Co.*, 336 U. S. 271, 276, 277, 93 L. Ed. 672, 677, 80 USPQ 451, 453.

We are aware that the plaintiff here successfully defended the validity of the patent in suit in the case of *Holstensson v. Webcor, Inc.*, 150 F. Supp. 441, 112 USPQ 463 (N. D. Ill. 1957). The able opinion of Judge Perry in that case does not, however, disclose that the legal questions upon which our decision turns were raised or considered in that case. No mention is made in the reported opinion of the old Arvidius Reissue Patent. District Judge Perry does not discuss the matter of overclaiming.

We are of the opinion that the Holstensson patent in suit is without validity as a combination patent and is likewise void for overclaiming.

The judgment of the District Court is reversed with direction to enter judgment dismissing the complaint.

JUDGMENT.

UNITED STATES COURT OF APPEALS,

For the Sixth Circuit.

No. 14,812.

Filed
Nov. 21, 1963

ANEL HARALD HOLSTENSSON and GLENVILLE INDUSTRIES, INC.,
Plaintiffs-Appellees,
vs.
V-M CORPORATION,
Defendant-Appellant.

Before: MILLER and O'SULLIVAN, Circuit Judges, and WILLIAM E. MILLER, District Judge.

APPEAL from the United States District Court for the Western District of Michigan.

THIS CAUSE came on to be heard on the transcript of the record from the United States District Court for the Western District of Michigan, and was argued by counsel.

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the Judgment of the said District Court in this cause be and the same is hereby reversed with direction to enter judgment dismissing the complaint.

Approved for entry:

s/ CLIFFORD O'SULLIVAN,
United States Circuit Judge.

No. 14,812.

UNITED STATES COURT OF APPEALS,

For the Sixth Circuit.

Filed
January 27, 1964

ORDER DENYING PETITION FOR REHEARING.

This cause is before this Court upon the petition of the plaintiffs-appellees for a rehearing, and the Court having read said petition, and on due consideration thereof, being of the opinion that the said petition should be denied,

IT IS ORDERED that the said petition for rehearing may be and the same is hereby denied.

Approved for entry:

/s/ CLIFFORD O'SULLIVAN,
Circuit Judge.

STATUTE.

35USC 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 USC 103. Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

R. S. 4887. Inventions previously patended abroad; right of priorty.

No person otherwise entitled thereto, shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section 31 of this title, and six months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application

for patent for the same invention, discovery, or design was first filed in such foreign country: *Provided*, That the application in this country is filed within twelve months, in cases within the provisions of section 31 of this title, and within six months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on any application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing. (R.S. sec. 4887; Mar. 3, 1897, ch. 391, sec. 3, 29 Stat. 693; Mar. 3, 1903, ch. 1019, sec. 1, 32 Stat. 1225; June 19, 1936, ch. 594, 49 Stat. 1529.)

Office Supreme Court, U.S.
FILED
MAY 22 1964
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 1034

AXEL HARALD HOLSTENSSON AND GLENVILLE INDUSTRIES, INC.,

Petitioners,

vs.

V-M CORPORATION,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

BRIEF FOR RESPONDENT IN OPPOSITION.

JOHN A. DIENNER,
EDWARD C. GRELLE,
53 W. Jackson Blvd.,
Chicago, Illinois,
JOSEPH D. HARTWIG,
203 State Bank Bldg.,
Benton Harbor, Michigan,
Attorneys for Respondent.

THE GUNTHORP-WARREN PRINTING COMPANY, CHICAGO

INDEX.

	PAGE
Opinions Below	1
Statutes and Treaty Involved	1
Jurisdiction	2
Conflicting Decisions	2
Alleged Conflict With a Treaty Between Sweden and the United States	3
Alleged Conflict With Requirement by United States Patent Office Which Patentees Were Forced to Accept	4
Questions Presented	5
Petitioners' Statement	6
Alleged Reasons for Granting the Writ	11
Conclusion	15

Table of Cases.

Axel Harald Holstensson et al. v. V-M Corporation, 198 F. Supp. 779 (D.C.W.D. Mich. S.D.)	1, 10
Axel Harald Holstensson et al. v. V-M Corporation, 325 F. (2d) 109 (C.A. 6th)	1, 2, 5, 7, 9
Bassick Mfg. Co. v. R. M. Hollingshead Co., 398 U. S. 415	11, 13, 14
Evans v. Eatons, 20 U. S. 356	11
Graver Mfg. Co. v. Linde Co., 336 U. S. 271	7
Holstensson v. Webcor Inc., 150 F. Supp. 441 (N. D. Ill. E. D.)	2, 12
Hyster Company v. Hunt Foods, Inc., 263 F. (2d) 130 (C. A. 7th)	11

Karl Zysset et al. v. Popeil Brothers, Inc., 276 F. (2d) 354 and 318 F. (2d) 701 (C. A. 7th) 3, 11

Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U. S. 545 ..... 3, 5, 11, 12, 13

Morton Salt Co. v. Suppiger Co., 314 U. S. 488 9

Precision Co. v. Automotive Co., 324 U. S. 806 7

Rudolph v. United States, 370 U. S. 269 10

Sears Roebuck & Co. v. Stiffel Co., 84 Su. Ct. 784 8

United Shoe Machinery Corp. v. Williams Mfg. Co., 29 F. Supp. 1915 (D.C.S.D. Ohio W.D.) 13

Williams Manufacturing Co. v. United Shoe Machinery Co., 316 U. S. 364 ..... 13, 14

Williams Manufacturing Co. v. United Shoe Machinery Co., 121 F. (2d) 273 (C.C.A. 6th) 13

CONSTITUTION.

Article 1, § 8, clause 8 ..... 7, 8

STATUTE.

35 U.S.C. 112 (Sec. 33 prior to 1953) 1, 5, 6

IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 1034

AXEL HARALD HOLSTENSSON AND GLENVIELE INDUSTRIES, INC.,

Petitioners,

vs.

V-M CORPORATION;

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

BRIEF FOR RESPONDENT IN OPPOSITION.

OPINIONS BELOW.

The opinion of the District Court is reported at 198 F. Supp. 779. The opinion of the Court of Appeals for the Sixth Circuit is reported at 325 F. (2d) 109 (incorrectly cited as 325 F. (2d) 234 in Petition).

STATUTES AND TREATY INVOLVED.

The decision of the Court of Appeals holding the patent invalid is based on the failure of the patentee to comply with Sec. 112 (Sec. 33 prior to 1953) of U. S. C. Title 35. Petitioners do not refer to this section of the statute.

The sections of the Patent Statutes and the International Convention referred to by them are irrelevant and immaterial. The reference to them is pointless.

JURISDICTION.

The jurisdictional requisites are adequately set forth in the Petition.

CONFLICTING DECISIONS.

The decision of the Court of Appeals is not in conflict with any other decision and is in conformity with numerous decisions by this Court and many Courts of Appeal, as will be pointed out more fully hereinafter. Petitioners assert that the District Court of Illinois in *Holstensson* v. *Webcor, Inc.*, held that the same claim here involved was valid and infringed; and in so doing a contrary interpretation of the same point of law was rendered". The incorrectness of this assertion is pointed out in the opinion of the Court of Appeals in this case as follows:

> "We are aware that the plaintiff here successfully defended the validity of the patent in suit in the case of *Holstensson* v. *Webcor, Inc.*, 150 F. Supp. 441, 112 USPQ 463 (N. D. Ill. 1957). The able opinion of Judge Perry in that case does not, however, disclose that the legal questions upon which our decision turns were raised or considered in that case."

An examination of the opinion of Judge Perry confirms this. The patent in suit expired July 28, 1959 so the question of validity or invalidity of the patent is immaterial, as far as the public is concerned. The District Court's decision by Judge Perry does not constitute a conflict of decisions between two courts of appeal (Rule 19, 1. (b).)

Petitioners also allege that there is a conflict with the decision of the Court of Appeals for the Seventh Circuit

in *Karl Zyssel et al. v. Popeil Brothers, Inc.*, 276 F. (2d) 354, 318 F. (2d) 701. There is no conflict, since in that case the facts are entirely different and the court did not pass on the legal proposition which determined the invalidity of the patent here in suit.

That legal proposition is set forth in the opinion of the Court of Appeals for the Sixth Circuit as follows:

> "Does the improvement of one part of an old combination give the right to claim, in a patent, that improvement in combination with other old parts which perform no new function in the combination?" 325 F. (2d) 234 at 111 (p. 22 of App. to Petition.)

That legal proposition was set forth by this Court in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545 at page 549 and this Court answered it in the negative. The Court of Appeals for the Sixth Circuit in the present case followed the decision of this Court in the *Lincoln Engineering* case and likewise answered that proposition of law in the negative. It held the claim in suit invalid because the improvement was in the spindle and that improvement was claimed in combination with other old parts of a record-changer which performed no new function in the combination, which was old.

ALLEGED CONFLICT WITH A TREATY BETWEEN SWEDEN AND THE UNITED STATES

The alleged conflict with a treaty between Sweden and the United States is a misrepresentation. The decision has nothing to do with the rights which the inventor or inventors had under the International Convention to take out a patent on an invention, or in regard to the formalities to be observed in doing so. The point which the Court makes is the recognition by the Swedish inventors that the spindle was a separate invention. They took a separate patent 97,123 on it and took a separate patent 97,122 on

the machine for playing records of different sizes. This matter of recognizing the spindle as a separate invention has nothing to do with any Treaty or with Swedish law. The issuance of the Swedish patent 97,123 on the spindle and its accessories is an evidentiary fact establishing that the Swedish inventors recognized the spindle as a separate invention from the rest of the talking machine. In further evidence of the separate invention, ascribed in the Swedish patent 97,123 to Arvidius alone, the Court in the present case questions whether A. H. Hoistensson was jointly an inventor with Arvidius, so fars as concerns the spindle.

ALLEGED CONFLICT WITH REQUIREMENT BY UNITED STATES PATENT OFFICE WHICH PATENTEES WERE FORCED TO ACCEPT.

Petitioners' assertion that the invalid claim is due to the requirement of the Patent Office which the patentees were forced to accept, is completely false. The Patent Office required the patentees to amend Claim 27, which became Claim 1 of the patent in suit. Claim 27 was invalid because of overclaiming when presented, but it did so in indefinite and functional terms. The Patent Office required these indefinite and functional terms to be corrected to recite structure. It did not cure the fault of the original claim of overclaiming, but merely made the terms of the claim more definite. That the Patent Office grants patents with claims on the spindle is shown by United States Letters Patent No. 2,523,045 covering defendant's improvement in its spindle. (Def's Ex. 54, p. 142a Brief and Appendix for Defendant-Appellant).

The Patent Examiner is not the one who lays down the law. He is merely an administrative officer whose duty it is to see, as far as he can, that the application when ready to be issued as a patent, complies with the law. If he imposes a requirement which is contrary to the law, the

applicant has his remedy by way of appeal. Applicant did not exhaust his remedy in the present case, if he had any basis for complaining.

There have been thousands of decisions holding patents invalid. In every such decision there was a conflict between the decision of the Court and the decision of the Patent Office.

QUESTIONS PRESENTED

The questions presented in the Petition are irrelevant and immaterial. The decision of the Court of Appeals depends on the answer to the question on which Respondent based its appeal, namely:

> "Does the improvement of one part of an old combination give the right to claim, in a patent, that improvement in combination with other old parts which perform no new function in the combination?" (See opinion 325 F. (2d) 234 at 111, p. 22 of App. to Petition.)

This question was answered in the negative by the Court of Appeals in the case at bar and by this Court in the *Lincoln Engineering* case as heretofore pointed out. The negative answer to this question is required by 35 U. S. C. 33 (now 112).

As pointed out in the opinion in this case, footnote 4, 325 F. (2d) 109 at 124 (p. 45 App. to Petition) the language of the Act in force at the time of the issuance of the patent in suit required that the applicant for a patent so describe his invention "so as to distinguish it from other inventions, and he shall particularly point out and distinctly claim the part, the improvement or combination which he claims as his invention or discovery."

Petitioners do not refer to the above mentioned question which is the basis of the decision and likewise do not refer to 35 U. S. C. 33 (now 112) which requires the

negative answer to the question. Since this Court will consider only the questions set forth in the Petition or fairly comprised therein (Rule 23, 1(c)) the Petition lacks any basis for consideration by this Court.

Question 1 set forth in the Petition is not involved in the decision in this case.

Question 2 states "When the Constitutional and Statutory tests for invention have been met, as here found by the Sixth Circuit Court of Appeals" etc. This is clearly incorrect. The Court of Appeals expressly held that the patentees did not comply with 35 U. S. C. 112 (formerly 35 U. S. C. 33).

Question 3 states "May a United States Court disregard the provisions of a treaty which the United States has with Sweden" etc. As heretofore pointed out, this case and the decision have nothing to do with any treaties.

Question 4 states, "Was the Constitution and Statutory standard for patentable invention as established by this Court met and satisfied by Claim 1" etc. This question has nothing to do with compliance with 35 USC 112. It is a requirement of a valid patent but it is in addition to complying with 35 USC 112.

Question 5 is not involved in this case.

PETITIONERS' STATEMENT

Under this heading in the Petition there are many misstatements, but we will refer to only a few. On page 6, petitioners refer to the defense upon which the Court of Appeals held the claim invalid as a "technical defense" and on page 4 as a "legal technicality." On page 20 they state, "This is contrary to all principles of equity, and to the concept that in a Court of Equity, justice should be done."

The Court based its decision of invalidity on the failure

to comply with 35 U. S. C. 33 (now 112). We submit that failure to comply with the requirements of the Patent Laws is *not* a "technical defense" or a "legal technicality", it goes to the very heart of the patentee's right. Without the statute there would be no patent monopoly. As pointed out in the opinion of the Court of Appeals,

> "there is no natural or common law right to a monopoly of an invention. Robinson Treatise on the Law of Patents (1890) § 24. By Constitutional grant, Article 1, § 8, Clause 8, Congress has power to give inventors, for a limited time, 'the exclusive right to their respective discoveries.' Applicants for such monopolies must comply with the requirements that Congress insists be met as a condition to exercising such monopoly."

As stated by this Court in *Graver Mfg. Co.* v. *Linde Co.*, 336 U. S. 271 at 275,

> "—the ultimate question of patentability is one of meeting the requirements of the statute—."

A patent is "a special privilege" and "is an exception to the general rule against monopolies." *Precision Co.* v. *Automotive Co.*, 324 U. S. 806 at 815, 816. The patentee cannot have a valid patent monopoly without complying with the statutes and the defense of failure to comply with the patent statutes is not a "technical defense."

Petitioners urge that the decision in the case at bar is "contrary to all principles of equity." The decision is based on the failure of the patentees to comply with the Patent Laws. If petitioners are urging that a *court* of equity should enforce a patent monopoly even though the Patent Laws have not been strictly complied with, we wish to point out that such a decision would be unconstitutional.

The Constitution, Article I, § 8 Clause 8 provides that *Congress* shall have the power to provide for the issuance of patents. This power is granted exclusively to *Congress*

under the express provisions of the Constitution. Congress has exercised this power by enacting the Patent Laws which must be strictly complied with in order to obtain a patent monopoly. Any grant of a patent monopoly by a *court of equity* where the Patent Laws have not been complied with, would be unconstitutional.

As stated by this Court in *Sears Roebuck & Co. v. Stiffel Co.*, 84 Su. Ct. 784 at 787,

> "Before the Constitution was adopted, some States had granted patent either by special act or by general statute, but when the Constitution was adopted provision for a federal patent law was made one of the enumerated powers of Congress because, as Madison put it in The Federalist No. 43, the States 'cannot make effectual provision' for either patents or copyrights. That constitutional provision is Art. 1, § 8, Cl. 8, which empowers Congress 'To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.' Pursuant to this constitutional authority, Congress in 1790 enacted the first federal patent and copyright law, 1 Stat. 109, and ever since that time has fixed the conditions upon which patents and copyrights shall be granted, see 17 USC §§ 1-215; 35 USC §§ 1-293. These laws, like other laws of the United States enacted pursuant to constitutional authority, are the supreme law of the land."

and at 788,

> "—The grant of a patent is the grant of a statutory monopoly; indeed, the grant of patents in England was an explicit exception of the statute of James I prohibiting monopolies."
>
> "—But in rewarding useful invention, the 'rights and welfare of the community must be fairly dealt with and effectually guarded.' *Kendall v. Winsor*, 21 How. 322, 392, (1859). To that end the prerequisites to obtaining a patent are strictly observed, and when the patent has issued the limitations on its exercise are equally strictly enforced."

Since Petitioners have referred to the equities, we wish to point out that the equities in this case are in favor of the Respondent and against the Petitioners. As pointed out in the opinion of the Court of Appeal, at page 51 of the Appendix to Petition, it would have been simple to have included a claim on the spindle by itself. Petitioners did not do so because of greed. They wanted to base the royalty in the licenses on the sale price of the record changer, rather than on the sale price of the spindle. It is well known that when a manufacturer is obliged to pay a royalty under a patent the public eventually pays by reason of a higher price. It would have been easy for Respondent to take a license and force the public to pay the royalty. Respondent did not consider it fair to the public to pass along this unjustifiable royalty and consequently Respondent refused to take a license.

Where a patentee claims more than his invention he is attempting to obtain a patent monopoly for more than his invention. This is against public policy. It is similar to a tying-in clause in a license agreement, where the patentee attempts to extend his monopoly to include unpatented materials outside of his invention.

As stated by this Court in *Morton Salt Co. v. Suppiger Co.*, 314 U. S. 488 at 492.

> "But the public policy which includes inventions within the granted monopoly excludes from it all that is not embraced in the invention."

On page 6, Petitioners assert, "The combination, as a whole was new—." The Court of Appeals expressly held that the combination was old and so did the District Court as pointed out in the opinion of the Court of Appeals (p. 37 of App. to Petition).

Petitioners attempt to create the impression that patentees' improvement was more than the spindle, is not

supported by the facts and is contrary to the findings of both the District Court and the Court of Appeals. The opinion of the Court of Appeals points out very carefully that the evidence establishes that the improvement was in the spindle and not in the combination. All that the patentees did was take the prior art record changer of Arvidius Reissue patent No. 20,819 and substitute the spindle record feeder for the pusher blades record feeder. As pointed out by the court this merely involved attaching the lever in the spindle to the link which previously operated the pusher blades (See p. 25 of Petition).

Petitioners contentions that these findings of fact by the lower courts are wrong and should be reviewed by this Court, show that they are seeking a review of the facts and not the law applied by the Court of Appeals. As pointed out by this Court in *Rudolph v. United States*, 370 U. S. 269 at 270, since a review of a factual matter "would be of no importance save to the litigants themselves", it is appropriate to dismiss the writ. This is especially true in the case at bar, as the patent expired July 28, 1959.

Respondent did not make and sell the spindle shown in the patent in suit. It developed its own spindle and obtained a patent on its invention, Miller patent No. 2,523,045, issued September 19, 1950. The District Court held,

> "At the outset it is quite obvious that the defendant's device and the Miller patent are a substantial improvement upon the device described in the Holstensson patent.— 'The fact that the device used by the defendant and described in the Miller patent is more effective, is probably more efficient, and unquestionably more satisfactory in use does not detract from the fact that it is an adaptation of the mechanical device described in the Holstensson patent." (109 F. Supp. 779 at 783).

It was not necessary to appeal from the holding of infringement by the District Court because, if the patent in suit is invalid, as has been held by the Court of Appeals, then the issue of infringement is moot, since you cannot infringe an invalid patent. *Hyster Company* v. *Hunt Foods, Inc.*, 263 F. (2d) 130 (CA 7th) at 134.

ALLEGED REASONS FOR GRANTING THE WRIT.

On page 8 Petitioners assert that "the Court has applied a new test which is to the effect that for a combination claim to be patentable, every element must be new or perform a new function. This is not correct. The Court held that the invention was in the spindle and that the patentees claimed the entire record changer which was more than their invention. They failed to "particularly point out and distinctly claim" the invention as required by 35 USC 33 (now 112). This is not a new test. It was set forth and followed by this Court in *Evans* v. *Eatons*, 20 U. S. 356; *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545; *Bassick Mfg. Co.* v. *R. M. Hollingshead Co.*, 398 U. S. 415 and many other cases and also by numerous Courts of Appeal decisions.

Petitioners allege on page 9, that there is a conflict between the case at bar and *Karl Zysset et al.* v. *Popeil Brothers, Inc.*, 276 F. (2d) 354 and 318 F. (2d) 701.

In the *Popeil* case there was no basis for holding that the inventor claimed more than his invention. The sinuous blade and clearing plate were disclosed in the prior art. As stated by the court in 318 F. (2d) 701 at 704,

> "'Except for disclosing a sinuous type of knife blade Wilson & McCallay is no better a prior-art reference than those originally cited, and considered and rejected, in *Zysset* v. *Popeil Brothers, Inc.*, *supra*. Its disclosure of a sinuous blade and a clearing plate is not an anticipation of the *combination* of Zysset."

The court also said at page 704,

> "It is the *combination* which was held valid and infringed—not any particular element thereof, per se."

and at page 705,

> "Defendant's contentions with respect to the disclosures of Wilson & McCallay, Galant and Hofmann are predicated upon its faulty assumption that it is one element, or something less than the whole of the combined elements, which is relied upon in Zysset to constitute patentable invention. And such is not the case."

The facts did not constitute a basis for applying the doctrine of the *Lincoln Engineering* case and other cases referred to by the court.

In the case at bar the court found that the patentees claimed more than their invention. Their invention was in the spindle only and they claimed the complete record changer. The court applied the doctrine of the *Lincoln Engineering* case and other cases and held the claim invalid. There is no conflict between the case at bar and the *Popeil* case.

On page 10, Petitioners allege that the decision in the case at bar is in conflict with the District Court decision in *Holstensson* v. *Webcor*, 150 F. Supp. 441. This District Court decision is no basis for granting certiorari, for the following reasons, heretofore explained in greater detail.

1. The legal questions upon which the decision in the case at bar turns were not raised or considered in that case.

2. The District Court decision does not constitute a conflict of decisions between two courts of appeal (Rule 19. 1. (b)).

3. The patent in suit expired July 28, 1959.

Starting on page 14, Petitioners discuss the case of

Williams Manufacturing Co. v. *United Shoe Machinery Corporation*, 316 U. S. 364. This case in the District Court involved two patents, McFeely patent No. 1,558,737 and Hoyt patent No. 1,5008,394. The District Court held both patents valid and infringed, 29 F. Supp. 1015. On appeal (121 F. (2d) 273) both patents were challenged on the doctrine of the *Lincoln Engineering* case, the *Bassick* case and other similar cases, but the court pointed to controlling differences in the two patents and sustained the McFeely patent as having a proper claim to a new combination of old elements producing a new and unobvious result, whereas, the Hoyt patent was held invalid because the improvement was in the heel band mechanism, and "it requires no reorganization of the machine nor any new mode of operation, and whatever improvement may result is due entirely to the improved element and cannot give rise to valid claims embracing the entire lasting mechanism." 121 F. (2d) 273 at 278.

The case then came up to the Supreme Court by way of certiorari, on petition by the defendant to review the decision sustaining the McFeely patent No. 1,558,737. The review was requested solely as to the McFeely patent, and the argument presented was that it also fell within the ban of the *Bassick* v. *Hollingshead* case and the *Lincoln Engineering Co.* v. *Stewart-Warner Corp.* case, 303 U. S. 545. This Court pointed out that the McFeely patent was for a combination of elements which constituted a patentable invention. This Court said on page 368:

> "In respect of each claimed combination both courts have found that they embody other improvements, in addition to mere manual preliminary adjustments, and that each combination exhibits invention in that its elements cooperate in a new and useful way to accomplish an improved result."

In answer to petitioner's contention that the claims of the McFeely patent are within the *Bassick* v. *Hollingshead* doctrine, this Court said further, p. 368:

> "We think, however, that each of the claims is confined to a combination of specified means applicable only to a restricted portion and function of the whole machine."

It is to be remembered that, in the case at bar, claim 1 in suit covers the entire record playing machine and not merely improvement in the record feeder.

The Supreme Court held that the claims of the McFeely patent were confined to a combination of specified means applicable only to a restricted portion and function of the whole machine, and that the claim was proper. The Court said, p. 370:

> "The present suit for infringement is not for the use of an automatic bed lasting and tacking machine as such. It is for the use in such a machine of improvements of certain features of the machine."

In brief, the history of the *Williams* v. *United Shoe Machinery Corp.* case demonstrates that the Supreme Court sustained a proper claim to a combination because it was limited to the improvements which the inventor had made.

The Court of Appeals had stricken the Hoyt patent which taught no more than the improvement of one element, because the patentee claimed a combination of the improvement along with old elements which contributed nothing in combination. The *Bassick* v. *Hollingshead* doctrine is in nowise "relaxed" by the decision of this Court in *Williams* v. *United Shoe Machinery* case, but is fully sustained and carefully applied to the appropriate facts.

The other decisions cited by Petitioners on pages 15 and 16 are not in point.

The treaties referred to on pages 16, 17 and 18 have

nothing to do with the case at bar. There is no question of an earlier date of invention under the treaty, because of filing an application in a foreign country.

CONCLUSION.

There is no basis for granting certiorari. The decision is not in conflict with any other decisions and is in conformity with many decisions by this Court and numerous decisions by Courts of Appeal. There is nothing in this case or in the petition which merits this Court's consideration.

The Petition for Writ of Certiorari should be denied.

Respectfully submitted.

JOHN A. DIENNER,
EDWARD C. GRELLE,
53 W. Jackson Blvd.,
Chicago, Illinois,
JOSEPH D. HARTWIG,
203 State Bank Bldg.,
Benton Harbor, Michigan,
Attorneys for Respondent.